

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-36 and 38-51 are currently pending, Claims 1, 15, 29, 32, 40, and 43 having been amended. The changes and additions to the claims do not add new matter and are supported by the originally filed specification, for example, on page 18, lines 16-24; and page 24, lines 3-5.

In the outstanding Office Action, Claims 1-36 and 38-50 were rejected under 35 U.S.C. §102(e) as being anticipated by Koga et al. (U.S. Patent No. 7,313,699, hereafter “Koga”).

With respect to the rejection of Claim 1 under 35 U.S.C. §102(e), Applicants respectfully submit that the amendment to Claim 1 overcomes this ground of rejection.

Amended Claim 1 recites, *inter alia*,

An image forming apparatus which is connected to a network and in which a plurality of applications installed, the image forming apparatus comprising:

a printer configured to produce a physical copy of a document;

an external server communication part, which sends the inputted user information to an external server through the internet and receives pre-registered user authentication information from the external server through the internet;

one or more authentication parts, which authenticate the user authentication information by comparing the received pre-registered user authentication information with the authentication information inputted by the user;

Applicants respectfully submit that Koga fails to disclose or suggest these features of Claim 1.

Koga is directed to an automatic authentication method and print process. Fig. 1 of Koga shows a system which includes a server 100, print server 101, clients 102-104, and

printers 105-108. Koga describes that a printer driver on either print server 101 or one of clients 102-104 sends a user authentication request to server 100 (see col. 8, lines 1-9). The server 100 then executes an authentication process on the basis of the document attribute information received from the printer driver and sends the authentication result to the printer driver (see col. 8, lines 16-21). The printer driver then performs a document print process and then sends printing attribute information to the server 100 to execute a print accounting control process (see col. 8, lines 22-31). The print driver also controls a target printer to print out a requested document (see col. 8, lines 32-37). Fig. 3 of Koga shows another view of how the system operates, which illustrates that the authentication process is performed on the external server and separately from the printer (see also, col. 10, lines 19-27).

The Office Action takes the position that Koga discloses the “external server communication part, which sends the inputted user information to an external server through the internet and receives pre-registered user authentication information from the external server through the internet,” and the “one or more authentication parts, which authenticate the user authentication information by comparing the received pre-registered user authentication information with the authentication information inputted by the user,” as recited in Claim 1. (See Office Action, at page 3, citing col. 4, lines 13-31, col. 4, lines 53-63, col. 5, lines 32-52, and col. 7, lines 29-33 of Koga).

However, amended Claim 1 clarifies that the claimed “image forming apparatus” comprises a “printer for producing a physical copy of a document.” Koga does not describe that *a printer* on the network, such as printers 106, 107, or 108 include “one or more authentication parts, which authenticate the user authentication information by comparing the received pre-registered user authentication information with the authentication information inputted by the user.” On the contrary, as described above, it is the server 100 of Koga which

performs the authentication and provides the result to a printer driver operating on either a print server 101 or a client terminal 102-104.

Therefore, Applicants submit that Koga is different from Claim 1 because Koga does not describe the printer device receiving user authentication information from the external server and then comparing the received pre-registered user authentication information with the authentication information inputted by the user.

Therefore, Applicants submit that Koga fails to disclose or suggest “an image forming apparatus...comprising: a printer configured to produce a physical copy of a document; an external server communication part, which sends the inputted user information to an external server through the internet and receives pre-registered user authentication information from the external server through the internet; one or more authentication parts, which authenticate the user authentication information by comparing the received pre-registered user authentication information with the authentication information inputted by the user,” as defined by Claim 1.

M.P.E.P. §2131 requires for anticipation that each and every feature of the claimed invention must be shown and requires for anticipation that the identical invention must be shown in as complete detail as contained in the claim.

For the reasons discussed above, Applicants submit that Koga does not show every feature of Claim 1 in as much detail as contained in the claim. Thus, Applicants respectfully submit that amended Claim 1 (and all associated dependent claims) patentably distinguishes over Koga.

Amended independent Claims 15, 29, 32, 40, and 43 recite features similar to those of Claim 1 discussed above. Therefore, Applicants respectfully submit that Claims 15, 29, 32, 40, and 43 (and all associated dependent claims) patentably distinguish over Koga, for similar reasons as discussed above with regard to Claim 1.

Furthermore, Applicants note that the outstanding Office Action did not address the features of dependent Claim 51. Additionally, the previous Office Action also did not address the features of dependent Claim 51.

The MPEP states in section 706.07:

“...present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.”


“The examiner should never lose sight of the fact that in every case applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.”

Therefore, Applicants respectfully submit that the finality of the Office Action must be withdrawn in this case because the Office Action did not properly address all the claimed features and therefore there is not a clear issue on whether or not the features of Claim 51 are rejected or allowable.

Consequently, in light of the above discussion and in view of the present amendment, the outstanding grounds for rejection are believed to have been overcome. The present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Sameer Gokhale
Registration No. 62,618

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)